

REMARKS

By this Amendment, claims 1, 7, 10 and 13 have been amended. Accordingly, 1-13 are pending in the present application.

Applicants wish to thank the Examiner for the courtesy extended to Applicants' attorney during a telephone interview on March 3, 2004. During the interview the cited prior art references and amendments made to the claims herein were discussed.

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art of Figure 11 in view of Warneke et al. Applicants respectfully traverse this rejection.

Among the limitations of independent claim 1 which are neither disclosed nor suggested in the prior art of record is a high-frequency circuit board unit having a semiconductor device which includes a semiconductor device having a non-high-frequency signal terminal which is "isolated from receipt of a surge voltage".

Among the limitations of independent claim 10 which are neither disclosed nor suggested in the prior art of record is a manufacturing method for a high-frequency circuit board which includes "mounting a semiconductor device including a high-frequency signal terminal and a non-high-frequency signal terminal on said first surface of said circuit board in such a manner that said high-frequency signal terminal is connected to a second terminal of said passive impedance circuit device and said non-high-frequency signal terminal is isolated from receipt of a surge voltage."

As admitted on page 2 of the Office Action, the admitted prior art of Fig. 11 neither teaches nor suggests a semiconductor device having a non-high frequency signal terminal which is isolated from receipt of a surge voltage.

Warneke et al. does not remedy any of the deficiencies of the prior art of Fig. 11. If one were to substitute the filter of Warneke et al. for the filter 15 shown in prior art Fig. 11 of the present application, a high-frequency signal would still be capable of damaging the semiconductor device through the terminal electrode 5a shown in Fig. 11 because there is no teaching or suggestion in either of the cited references to convert the connecting land 8b of Fig. 11 to a non-high-frequency signal terminal which is isolated from receipt of a surge voltage as required by independent claims 1 and 10.

In fact, inasmuch as the combination of the admitted prior art of Fig. 11 and Warneke et al. teach that a high-frequency signal would still be capable of damaging the semiconductor device through the terminal electrode 5a (and connecting land 8b), the combination suggested in the Office Action teaches away from the present invention as defined in independent claims 1 and 10. Accordingly, it is respectfully submitted that independent claims 1 and 10 patentably distinguish over the art of record.

Claims 2-9 depend either directly or indirectly from independent claim 1 and include all of the limitations found therein. Claims 11-13 depend either directly or indirectly from independent claim 10 and include all of the limitations found therein. Each of these dependent claims include additional limitations which, in combination with the limitations of the claims from which they depend, are neither disclosed nor suggested in the prior art of record. Accordingly, claims 2-9 and 11-13 are likewise patentable.

In view of the foregoing, favorable consideration of the amendments to claims 1, 7, 10 and 13, and allowance of the present application with claims 1-13 is respectfully and earnestly solicited.

Dated: March 8, 2004

Respectfully submitted,

By Richard LaCava

Richard LaCava

Registration No.: 41,135

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant